

REMARKS

For the following reason, further consideration of this application is now requested. In particular, it is applicant's position that the new grounds of rejection contained in the Examiner's last action are inappropriate and should be withdrawn, it being submitted that the rejections under 35 USC § 103 based on a combination of the Doyle and Uhl patents, with or without the Lanni et al. patent were made due to an erroneous interpretation of the Uhl reference.

As was pointed out previously, Doyle does not disclose or suggest a particular microscope having an epi-fluorescence illumination mode and a transmitted light-illumination mode, nor does he disclose that the wavelength of the illumination light emitted by the light source may be variable. All that Doyle discloses is a microscope having a transmitted light illumination mode and in which a reflector is provided at the side of the sample facing away from the objective lens to reflect light which has been focused onto the same by the objective lens and which has been transmitted through the sample, back onto the sample. Furthermore, as recognized by the Examiner, Doyle's light source is adapted only for transmission viewing and no epi-fluorescence excitation takes place using light of a different wavelength from the same light source.

For this reason, the Examiner has turned to the Uhl reference. While the Examiner may be correct that the Uhl light source produces excitation light having a wavelength which can be selected by a movable holographic three-dimensional grating, and this excitation light is passed into the microscope objective 10 by reflection at the beam splitter 9 which is essentially permeable for the fluorescence light emitted by the sample, it is not correct that Uhl's microscope is designed for transmission illumination or illumination viewing of the sample. To the contrary, Uhl's light source does not emit light for illumination, nor is his beam splitter essentially permeable for transmission illumination light.

Thus, the Examiner is, in essence, combining apples and oranges to produce grapes. Doyle relates solely to a transmission microscope and Uhl relates solely to a fluorescence microscope. The Examiner fails to provide any reason why one skilled in the art would combine the features of two microscopes that are operating based on two entirely different principles. Moreover, it is not seen how, even if made, any combination of these two references could lead one of ordinary skill in the art to the presently claimed invention. That

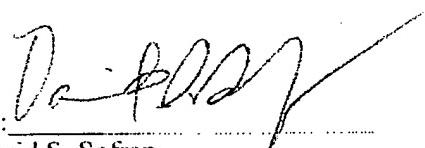
is, since neither Doyle nor Uhl teach to switch the same light source between fluorescence excitation light and transmission illumination light, and to make the microscope functional with both types of light by making the beam splitter essentially permeable for light transmission light, a reading of this two references would not lead to a single combination microscope capable of functioning in the manner of both types of microscopes as claimed by the present applicant.

As for the Lanni et al. patent, it is merely relied upon for its teaching of the use of an immersion liquid. However, there is nothing in the disclosure of the Lanni et al. patent which could overcome the basic deficiencies in the Examiner's proposed combination of the Doyle illumination microscope with the Uhl fluorescence excitation microscope.

Therefore, the rejections of the claims under 35 U.S.C. 103(a), based upon the Doyle and Uhl references, with and without the Lanni et al. reference, are improper and should now be withdrawn.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

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